

**REMARKS**

Claims 4-5 are pending. Claims 4-5 are rejected. Claim 4 is amended herein.

**Rejection of Claims 4-5 Under 35 U.S.C. §102.**

Claims 4-5 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,676,511 issued to *Mackie* (hereafter referred to as "*Mackie*"). Applicant respectfully traverses the Examiner's rejection of those Claims under 35 U.S.C. § 102.

To begin with, the Examiner erroneously contends that a "post" disclosed in *Mackie* is equivalent to the "punching bag having a cover and filler material" of Claims 4-5. Applicant recognizes that during examination a claim must be given its broadest reasonable interpretation, but the interpretation must be consistent with the specification. MPEP 2111; *Phillips v. AWH Corp.*, 415 F3d. 1303, 75 USPQ 1321 (Fed. Cir. 2005). The interpretation of the claim must also be consistent with the interpretation that would be reached by those of ordinary skill in the art. *Id.*; also *In re Cortwright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464 (Fed. Cir. 1999). It is inconceivable that one of ordinary skill would describe a post having faces "formed by 22 gauge sheet metal" or "steel channels" as a "punching bag having a cover and filler material". (*Mackie* 2:65 and 3:40). Such a broad interpretation is not within the plain meaning of "punching bag", is not consistent with the use of the term within the specification, and is not reasonable. One of ordinary skill in the art would understand a "punching bag having a cover and filler material" to be, as disclosed in the specification, "a normal

surface material, such as leather, or plastic, or a sturdy cloth, and a normal filler, such as rag." (Applicant's specification, p.7).

Moreover, the Examiner does not clearly point out what he considers to be a "filler material" in *Mackie*. Applicant submits that this is because *Mackie* does not disclose a filler material. As previously mentioned, the target of *Mackie* is constructed of steel and is intended to receive impacts from balls, not a strike from the human body. Accordingly, the sturdy steel framework as disclosed in Figs. 1-28 of *Mackie* is essentially hollow with no need for a filler. In contrast, a punching bag contains filler to absorb the strike and prevent injury to the user.

The Examiner also erroneously equates "a means for actuating said whistle" with a ball. Applicant submits that a ball by itself is not a means capable of actuating a whistle. Rather, the ball of *Mackie* more closely equates to the fist of the user as he strikes the compressible pneumatic targets. Hence, *Mackie* does not disclose a means for actuating said whistle.

Additionally, the Examiner expressly acknowledges that "Mackie does not disclose his device as including a hose." Accordingly, Applicant submits that *Mackie* does not include each and every element as set forth in Claim 5, and requests that the Examiner withdraw the rejection of Claim 5.

In light of the above arguments, *Mackie* fails to describe all of the limitations of the claims. Therefore, applicant respectfully submits that *Mackie* does not anticipate claims 4-5.

In addition, Claim 4 has been amended herein to include pneumatic targets that are positioned to receive a strike from a user, and a whistle that is sized and shaped to audibly indicate the accuracy and force of the strike by the user. The MPEP states,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

MPEP § 2131.

Since *Mackie* fails to describe pneumatic targets that are positioned to receive a strike from a user, and a whistle that is sized and shaped to audibly indicate the accuracy and force of the strike by the user, Applicant respectfully submits that Claim 4 is not anticipated by *Mackie*.

Therefore, Applicant requests that Examiner withdraw the rejection of claims 4-5 under 35 U.S.C. §102(b).

#### **Rejection of Claim 5 Under 35 U.S.C. §103.**

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Mackie* in view of the Examiner's judicial notice that the whistle means is known to be actuated by a volume of air and pneumatic targets are known to include hose members.

Applicant respectfully traverses the Examiner's rejection of those Claims under 35 U.S.C. § 103. Specifically, Applicant believes the Examiner has not established a *prima facie* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure ("MPEP"). The MPEP states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 706.02(j) (emphasis added).

As noted above, the Examiner acknowledges that "Mackie does not disclose his device as including a hose." The Examiner improperly attempts to supply the missing element by taking judicial notice without any documentary evidence to support his conclusion. Rather, the Examiner relies on his own personal knowledge and the general knowledge in the prior art to support his obviousness rejection. The Examiner's ability to use such personal and general knowledge is subject to 37 CFR §1.104(d)(2), which states:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." See 37 CFR §1.104(d)(2).

Therefore, Applicant requests under 37 CFR §1.107(b) that the Examiner provide an affidavit in conformance with §1.104(d)(2). Applicant points out that general skill in the art will rarely operate to supply missing knowledge or prior art to reach an obvious judgment. As stated by the Federal Circuit:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Sang Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claim 5 as being obvious under 35 U.S.C. § 103.

### **Conclusion.**

Applicant believes the above analysis made herein overcomes all of the Examiner's objections and rejections and that claims 4-5 are in condition for allowance. The Applicant urges the Examiner to issue a timely Notice of Allowance for those claims.

App. No. 10/790,300  
DN: BOOK 9341US

The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17, which may be required by this paper to Deposit Account 162201.

Respectfully submitted,

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